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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,097	08/26/2003	Timothy B. Carroll		6438

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EXAMINER

FULTON, CHRISTOPHER W

ART UNIT PAPER NUMBER

2859

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/650,097

Applicant(s)

CARROLL, TIMOTHY B.

Examiner

Christopher W. Fulton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-7,9 and 10 is/are rejected.
7) ☒ Claim(s) 8 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 26 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Dickens.

The device as claimed is substantially disclosed by Shaw with a top guide (upper section of 13) having an upper surface and a lower surface, wherein the lower surface is positioned to bear against the top surface of the object, an edge guide (lower back section of 13) positioned to bear against the edge of the object, and an opening through the device where the measuring tape 5 is inserted through the device, but lacks the opening being a trough in the upper surface of the top guide. Dickens teaches using a trough in the upper surface of an edge guided device for a tape to be extended through so the indicia on the top surface of the tape can be viewed without obstruction. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to move the opening of Shaw to the upper surface of the device as taught by Dickens so the indicia of the tape can be viewed without obstruction.

3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Dickens as applied to claim 1 above, and further in view of Burnett.

The device as claimed is disclosed by the combination of Shaw and Dickins together as stated in the rejection recited above for claim 1, but lack an index finger hole through the edge guide to aide the user in holding the device during use of the device. Burnett teaches using a through hole in a guide device for insertion of a finger to aide in holding the device during use of the device. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make a through hole in the edge guide of the combination of Shaw and Dickins as taught by Burnett for insertion of a finger to aide the user in holding the device during use of the device.

4. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Dickins as applied to claim 1 above, and further in view of Nicely.

The device as claimed is disclosed by the combination of Shaw and Dickins together as stated in the rejection recited above for claim 1, but lack a finger trough on the back side of the edge guide to aide the user in holding the device during use of the device and a relief bevel on the contact side of the edge guide so the device will slide easier along the edge of the object. Nicely teaches using a finger trough on the back side of the edge guide to aide the user in holding the device during use of the device and a relief bevel on the contact side of the edge guide so the device will slide easier along the edge of the object. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make a finger trough on the back side of the edge guide of the combination of Shaw and Dickins as taught by Nicely to aide the user in holding the device during use of the device. It also would have been obvious to one of ordinary skill in the art at the time the invention was made to make a relief bevel on the contact

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side of the edge guide of the combination of Shaw and Dickins as taught by Nicely so the device will slide easier along the edge of the object.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Dickins as applied to claim 1 above, and further in view of Harris.

The device as claimed is disclosed by the combination of Shaw and Dickins together as stated in the rejection recited above for claim 1, but lack a reference mark on the upper surface of the top guide to aide in locating the edge of the object during use of the object. Harris teaches using a reference mark 60 on the upper surface of the top guide to aide in determining the distance from the marking element to the edge of the object. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a reference mark on the upper surface of the top guide of the combination of Shaw and Dickins as taught by Harris to indicate the location of the edge of the object for determining the distance of the marker from the edge of the object.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Burnett.

The device as claimed is substantially disclosed by Shaw with a top guide (upper section of 13) having an upper surface and a lower surface, wherein the lower surface is positioned to bear against the top surface of the object, an edge guide (lower back section of 13) positioned to bear against the edge of the object, and an opening through the device where the measuring tape 5 is inserted through the device, but lacks an index finger hole through the edge guide to aide the user in holding the device during use of the device. Burnett teaches using a through hole in a

guide device for insertion of a finger to aide in holding the device during use of the device.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make a through hole in the edge guide of Shaw as taught by Burnett for insertion of a finger to aide the user in holding the device during use of the device.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Burnett as applied to claim 6 above, and further in view of Dickens.

The device as claimed is disclosed by the combination of Shaw and Burnett together as stated in the rejection recited above for claim 6, but lack the opening being a trough in the upper surface of the top guide. Dickens teaches using a trough in the upper surface of an edge guided device for a tape to be extended through so the indicia on the top surface of the tape can be viewed without obstruction. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to move the opening of the combination of Shaw and Burnett to the upper surface of the device as taught by Dickens so the indicia of the tape can be viewed without obstruction.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Burnett as applied to claim 6 above, and further in view of Nicely.

The device as claimed is disclosed by the combination of Shaw and Burnett together as stated in the rejection recited above for claim 6, but lack a relief bevel on the contact side of the edge guide so the device will slide easier along the edge of the object. Nicely teaches using a relief bevel on the contact side of the edge guide so the device will slide easier along the edge of the object. Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to make a relief bevel on the contact side of the edge guide of the combination of Shaw and Burnett as taught by Nicely so the device will slide easier along the edge of the object.

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Burnett as applied to claim 6 above, and further in view of Harris.

The device as claimed is disclosed by the combination of Shaw and Burnett together as stated in the rejection recited above for claim 6, but lack a reference mark on the upper surface of the top guide to aide in locating the edge of the object during use of the object. Harris teaches using a reference mark 60 on the upper surface of the top guide to aide in determining the distance from the marking element to the edge of the object. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a reference mark on the upper surface of the top guide of the combination of Shaw and Burnett as taught by Harris to indicate the location of the edge of the object for determining the distance of the marker from the edge of the object.

Response to Arguments

10. Applicant's arguments filed November 15, 2004 have been fully considered but they are not persuasive.

The amendment to claim 1 overcomes the 35 U.S.C. 112 rejection.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into

account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Dickins teaches using a trough in the upper surface of an edge guided device for a tape to be extended through so the indicia on the top surface of the tape can be viewed without obstruction. With respect to the argument of destroying the base reference of Shaw by making a trough in the top of member 13 because of the set screw 17 is not persuasive because the set screw does not go through block 13, but block 16, therefore the trough in block 13 would not effect the securing of the tape member 5.

The argument regarding claim 2 is not persuasive because When holding the base reference of Shaw the user would grasp the device with the fingers on the underside of the device adjacent the edge guide, therefore one of ordinary skill in the art would place the finger guide taught by the Burnett reference at a location to accommodate the fingers of the user to aide in

holding the device. With respect to the size of the hole, the users finger is not (and cannot) be claimed and therefore the size of the finger hole cannot be related to the users finger size.

The argument regarding claim 3 is not persuasive since the specific finger used is intended use and only the structural limitations are considered in the rejection.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Burnett teaches using a through hole in a guide device for insertion of a finger to aide in holding the device during use of the device.

Allowable Subject Matter

11. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dickins shows a finger guide with a trough as claimed in the broader independent claims.

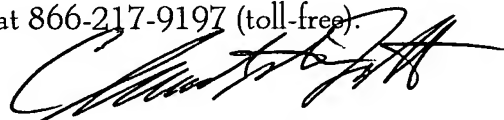
13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher W. Fulton whose telephone number is (571) 272-2242. The examiner can normally be reached on M-Th 5:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher W. Fulton
Primary Examiner
Art Unit 2859

CWF